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| 10/654,733 | 09/04/2003 | Emrys J. Williams | 5681-20500 | 7364 |
| 35690 | 7590 | 07/24/2006 | EXAMINER | |
| MEYERTONS, HOOD, KIVLIN, KOWERT & GOETZEL, P.C. 700 LAVACA, SUITE 800 AUSTIN, TX 78701 | | | AGWUMEZIE, CHARLES C | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3621 | |

DATE MAILED: 07/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|---|---|--|
| Office Action Summary | Application No. 10/654,733 | Applicant(s) WILLIAMS, EMRYS J. | |
| | Examiner Charlie C. Agwumezie | Art Unit 3621 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>12/22/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 7-11, 14-16, 26-34, 36-37, and 39, are rejected under 35

U.S.C. 102(e) as being anticipated by Pitroda U.S. Patent Application Publication No. 2005/0247777 A1.

As per **claims 1, 9, 15, and 16**, Pitroda discloses an Apparatus for use in transactions, comprising:

non-volatile memory containing a set of multiple identifiers associated with a customer account, wherein said multiple identifiers are also known to an agency providing said customer account (figs. 1, 12, 13, and 14; 0007), and

a processor operable to select one identifier from said set of multiple identifiers for use with any transaction involving said customer account (figs. 12, 13, and 14; 0007).

As per **claim 2, 10**, Pitroda further discloses the apparatus, wherein each of the

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identifiers in said set of multiple identifiers is allocated by the agency uniquely to the apparatus (figs. 12, 13 and 14; 0007).

As per **claim 3**, Pitroda further discloses the apparatus, further comprising a communications facility to engage a terminal, wherein the apparatus is operable to receive bill details for a transaction from the terminal, to generate a transaction record from the bill details, and to transmit the transaction record to the terminal (0007; 0008; 0072).

As per **claim 7**, Pitroda further discloses the apparatus, wherein said apparatus is operable to engage a first class of terminals for making a transaction, and a second class of terminals to enter or to update account information stored in the non-volatile memory (see figs. 2, 3, 5, 7 and 11; 0007; 0008; 0072).

As per **claim 8**, Pitroda further discloses the apparatus, further comprising first and second power circuits that are activated by said first and second class of terminals respectively, wherein activation of said second power circuit does not allow account information to be entered or updated in at least certain portions of said non-volatile memory (see figs. 2, 3, 5, 7 and 11; 0007; 0008; 0100).

As per **claim 11**, Pitroda further discloses the method, wherein making a transaction further comprises:

engaging a terminal, receiving bill details for a transaction from the terminal, generating a transaction record from the bill details, and transmitting the transaction record to the terminal (see fig. 2; 0007; 0008; 0087; 0100).

As per **claim 14**, Pitroda further discloses the method, further comprising limiting the transaction rate of the device to prevent rapid read-out of the identifiers (0072).

As per **claim 26**, Pitroda discloses a method for performing a transaction at a terminal using a portable transaction device, comprising:

generating a bill for the transaction at the terminal, engaging the portable transaction device with the terminal (fig. 2), transmitting the bill from the terminal to the transaction device (fig. 8), selecting one identifier from a set of multiple identifiers stored on the transaction device for use in the transaction (figs. 12, 13, and 14), generating a transaction record on the transaction device (figs. 16 and 18), the transaction record incorporating information from the bill and the selected identifier, and transmitting the transaction record to the terminal (figs. 15, 16 and 17; 0089; 0099).

As per **claim 27**, Pitroda further discloses the method, wherein the transaction record includes a digital signature from the transaction device (0089).

As per **claim 28**, Pitroda further discloses the method, wherein the transaction device is associated with a customer account, and wherein said multiple identifiers are

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also known to an agency providing said customer account, the method further comprising: transmitting the transaction record from the terminal to an agency computer, accessing an account record for the customer account based on the selected identifier included in the transaction record, validating the transaction, and updating the account record in respect of the validated transaction (figs. 15, 16 and 17; 0089; 0099).

As per **claim 29**, Pitroda further discloses the method, wherein prior to transmitting the transaction record from the terminal to the agency computer, the terminal incorporates its own copy of the bill into the transaction record (0089; 0099).

As per **claim 30**, Pitroda further discloses a method of operating a computer account system at an agency, said agency maintaining a plurality of customer accounts on the computer account system, wherein each customer account has a set of multiple identifiers associated therewith, the method comprising:

receiving a request for a transaction on a customer account, accessing an identifier within the request, determining which set of multiple identifiers the accessed identifier belongs to, and from this determining a customer account for the transaction, and updating the determined customer account in respect of the transaction (figs. 2; 15, 16 and 17; 0089; 0099).

As per **claim 31**, Pitroda further discloses the method, wherein determining which set of multiple identifiers the accessed identifier belongs to comprises accessing

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an index that maps identifiers to corresponding account records (figs. 15, 16 and 17; 0089; 0098; 0099).

As per **claim 32**, Pitroda further discloses the method, wherein the request includes a digital signature generated by a transaction device associated with a customer account, and the method further comprises validating the digital signature (figs. 15, 16 and 17; 0066; 0067; 0079; 0089; 0099).

As per claim 33, Pitroda further discloses the method, further comprising opening a new customer account by: creating a new account record for the new customer account, and storing a set of multiple identifiers associated with the new customer account into the new account record (0088; 0095; "user activates the account").

As per **claim 34**, Pitroda further discloses the method, further comprising: generating the set of multiple identifiers associated with the new customer account, and transmitting the generated set of multiple identifiers to a customer transaction device for use with the new customer account (figs. 15, and 16 0089; 0099).

As per **claims 36 and 39**, Pitroda discloses a computer account system at an agency, said system comprising:

a plurality of customer account records, wherein each customer account record incorporates a set of multiple identifiers associated therewith (fig. 13), and an index that

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maps identifiers to corresponding account records, wherein the system is responsive to receiving a request for a transaction on a customer account to access an identifier within the request in order to determine which set of multiple identifiers and hence which customer account the accessed identifier belongs to (figs. 12, 13, 14, 15; 0089; 0098; 0099; 0100).

As per claim 37, Pitroda further discloses the system, wherein the multiple identifiers associated with a customer account record are unique to that account record (fig. 13; 0066; 0070).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-6, 12-13, 35 and 38, are rejected under 35 U.S.C. 103(a) as being unpatentable over Pitroda U.S. Patent Application Publication No. 2005/0247777 A1 in view of Mann, III et al U.S. Patent Application Publication No 2006/0122943 A1.

As per **claim 4 and 12**, Pitroda failed to explicitly disclose the apparatus, wherein the transaction record includes a digital signature that is generated using a cryptographic key contained within the non-volatile memory.

Mann, III et al discloses the apparatus, wherein the transaction record includes a digital signature that is generated using a cryptographic key contained within the non-volatile memory (0080; 0093).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Pitroda and incorporate the apparatus, wherein the transaction record includes a digital signature that is generated using a cryptographic key contained within the non-volatile memory as taught by Mann, III et al in order to ensure adequate security.

As per **claim 5 and 13**, Pitroda failed to explicitly disclose the apparatus, wherein the transaction record is encrypted.

Mann, III et al discloses the apparatus, wherein the transaction record is encrypted (0080).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Pitroda and incorporate the apparatus, wherein the transaction record is encrypted as taught by Mann, III et al in order to ensure adequate security.

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As per claim 6, Pitroda failed to explicitly disclose the apparatus, wherein said apparatus is provided within inert packaging to allow implantation into the human body.

Mann, III et al discloses the apparatus, wherein said apparatus is provided within inert packaging to allow implantation into the human body (0042; 0051).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Pitroda and incorporate the apparatus, wherein said apparatus is provided within inert packaging to allow implantation into the human body as taught by Mann, III et al in order to ensure adequate security.

As per claim 35 and 38, Pitroda failed to explicitly disclose the method, further comprising generating at least one cryptographic key for use in communications between the computer account system and the customer transaction device.

Mann, III et al discloses the method, further comprising generating at least one cryptographic key for use in communications between the computer account system and the customer transaction device (0100).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Pitroda and incorporate the method, further comprising generating at least one cryptographic key for use in communications between the computer account system and the customer transaction device as taught by Mann, III et al in order to ensure adequate security.

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3. **Claims 17-25**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Wynn U.S. Patent No. RE38,137 E.

As per **claim 17 and 20**, Wynn discloses a method for opening an account on a portable transaction device comprising:

opening an account record in an agency computer system, wherein said agency is to provide the account, generating a set of multiple identifiers to be used for transactions on the account, storing the set of multiple identifiers in the agency computer system, and storing the set of multiple identifiers on the portable transaction device (fig. 10; col. 4, line 55-col. 5, line 5).

Wynn however did not explicitly mention identifiers. Wynn discloses the use of different account numbers stored in the UFDC. The use of identifiers or account numbers to designate credit cards are well known in the art. Accordingly it would have been obvious to one of ordinary skill in the art to modify the method of Wynn by incorporating the use of identifiers.

As per **claim 18**, Wynn further discloses the method, wherein the identifiers are unique to the account for the agency (col. 4, line 55-col. 5, line 5).

As per **claim 19**, Wynn failed to explicitly disclose the method further comprising adding the identifiers to an index, wherein said index maps from an identifier to the corresponding account. Wynn however discloses storing the accounts in an organized

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manner (col. 5, lines 5-15; col. 6, lines 5-25). Thus it would have been obvious to one of ordinary skill to list or index the account for easy selection during processing.

As per **claim 21**, Wynn discloses that each account contains the information relating to issuer name, address, contact information etc. Accordingly the accounts are unrelated to one another (col. 4, line 55-col. 5, line 5).

As per **claim 22**, Wynn further discloses the method, wherein the identifiers are generated on the agency computer system, and are transmitted to the portable transaction device for storage thereon (fig. 1, 3 and 4; col. 4, line 55-col. 5, line 5).

As per **claim 23**, Wynn further discloses the method, further comprising generating at least one cryptographic key for use with the account (col. 4, lines 45-55).

As per **claim 24**, Wynn further discloses the method, further comprising making a prepayment onto the account prior to using the account for transactions (fig. 10).

As per **claim 25**, Wynn further discloses the method, further comprising establishing an identity of a person who is to hold the account prior to opening the account (fig. 10).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The reference cited to Keresman, III et al U.S. Patent Application Publication No. 2002/0120583 A1 is a document considered relevant to the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles C. Agwumezie whose number is **(571) 272-6838**. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on **(571) 272 – 6712**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Any response to this action should be mailed to:

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Or faxed to:

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(571) 273-8300. [Official communications; including After Final communications labeled "Box AF"].

(571) 273-8300. [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"].

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CHARLIE LION AGWUMEZIE
PRIMARY EXAMINER

Charlie Lion Agwumezie
Patent Examiner
Art Unit 3621
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